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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/412,087 | 10/04/1999 | GARY L. BURGE | 1355-171C | 9198 |
| 8698 | 7590 | 02/06/2006 | EXAMINER | |
| STANDLEY LAW GROUP LLP 495 METRO PLACE SOUTH SUITE 210 DUBLIN, OH 43017 | | | CHAMPAGNE, DONALD | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3622 | |

DATE MAILED: 02/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/412,087

Applicant(s)

BURGE ET AL.

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 6-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 16-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 October 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 18 October 2005 has been entered.

Response to Arguments

2. Applicant's arguments filed with an amendment on 18 October 2005 have been fully considered but they are not persuasive. The arguments are addressed at para. 8-12 below.

Claim Rejections - 35 USC § 102 and 35 USC § 103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 5, 16 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Lemon et al. (US pat. 4,674,041).
6. Lemon et al. teaches (independent claims 1 and 16) a system for customizing displays and an electronic marketing system, the electronic marketing system comprising: *memory 56* (col. 8 lines 32-34), which reads on a (database) of *coupon transaction histories* (a plurality

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of electronic user profiles) and a database for storing *coupons to be displayed* (merchant data for a plurality of merchants, col. 3 lines 36-38 and 61-62, and col. 6 lines 30-32); a predictive model for selecting coupons to be displayed based on the customer's coupon transaction history, where said coupon selection for display reads on selecting actual display characteristics (the display of the individual coupons and their presentation) conforming to monitored user preferences (the *coupon transaction histories*) for presentation of merchant data (the coupons) on said computer display (col. 5 lines 8-10) in accordance with one of said electronic user profiles/*coupon transaction histories* and said merchant data (the coupon choice decisions made by the manufacturers/retailers sponsoring the coupons) from said plurality of merchants in said database, and a computer display comprising said actual display characteristics and said merchant data from said plurality of merchants, said computer display unique to a user with said one of said plurality of electronic user profiles/*coupon transaction histories* based on said actual display characteristics for presentation of said merchant data.

7. For claim 1, Lemon et al. also teaches a process at a host computer (*host computer H*) for selecting a plurality of actual display characteristics (col. 4 lines 35-40), and a "shopper's computer" (*terminal T with customer interface*, col. 4 lines 15-22 and Fig. 2; see para. 11 below).
8. Applicant argues (p. 10 of 13, bottom para.), "... coupon transaction histories (i.e., lists of coupons selected by customers) are not electronic user profiles with navigational and personal data and that coupons to be displayed to customers are not merchant data as claimed in the present application." First, all of these data limitations are non-structural. Apparatus/system claims must be distinguishable over the prior art in terms of their structure (MPEP § 2114). Second, the merits of applicant's argument must depend on the interpretation of the pertinent terms.
9. Note on interpretation of claim terms Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and

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bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...".

10. The instant application contains no such clear definition for the claimed phrase "electronic user profile data comprising on-line behavior data regarding a user's navigational choices and personal data". Indeed, the examiner could not find this phrase in the parent application as patented (US006014638A). The disclosed definition is limited to the claimed phrase itself. In the instant case, the examiner is required to give the claim term "electronic user profile data comprising on-line behavior data regarding a user's navigational choices and personal data" its broadest reasonable interpretation, which the examiner judges to be any on-line behavior data regarding a user's navigational choices and personal data. The references teaches (col. 8 lines 32-37) an on-line database of the customer/user coupon transaction/selection history, which reads on the user's navigational choices, and the customer's credit account numbers, which teaches personal data.
11. There is similarly no clear definition in the spec. for the claimed phrase "merchant data", so the examiner interpreted that as any information about the merchant. The merchant's coupons read on that. Similarly, the examiner interpreted a "shopper's computer" as a computer used by a shopper.
12. Applicant argues (p. 11 of 13, bottom para.), "Lemon does not teach monitoring of user preferences and does not teach actual display elements that are based on display parameters indicating user preferences." Applicant is not correct. Lemon et al. teaches monitoring a given user's coupon choice (*coupon transaction history*, col. 8 lines 36-37), which reads on monitoring of user preferences. Lemon et al. also teaches using this *coupon transaction history* to as a basis to limit the display of coupons to the particular user (col. 10 lines 24-20), which reads on actual display elements that are based on display parameters (i.e. the particular coupon design, such as Fig. 3b) indicating user preferences.
13. Lemon et al. also teaches at the citations given above claims 2, 5 and 18. Claim 2 does not add a patentable, structural, limitation to claim 1. Even if it did, the plurality of *terminals T* (col. 4 lines 15-22) would read on "selected sites".

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14. Claims 3, 4, 17, 19 and 20 are rejected under 35 U.S.C. 103(a) as being obvious over Lemon et al. (US pat. 4,674,041).
15. Lemon et al. does not teach (claims 3 and 17) that personal data includes age, sex and hobbies. Official notice is taken (MPEP § 2144.03) that it was common, at the time of the instant invention, to monitor these demographic parameters for marketing purposes. Because it is obvious to follow common practices, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Lemon et al. that electronic user profile data include age, sex and hobbies.
16. Lemon et al. does not teach (claims 4, 19 and 20) that the coupons/display model parameters include colors. Official notice is taken (MPEP § 2144.03) that it was common, at the time of the instant invention, to produce colored coupons. Because it is obvious to follow common practices, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Lemon et al. that the coupons be displayed in color.

Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
18. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on

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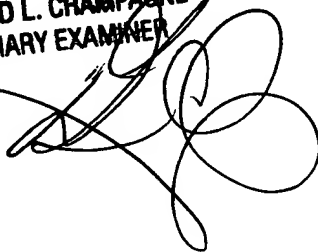
access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

20. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

DONALD L. CHAMPAGNE
PRIMARY EXAMINER

Donald L. Champagne
Primary Examiner
Art Unit 3622

28 January 2006

A handwritten signature in black ink, appearing to be 'DL Champagne', written over the printed name and title.